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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,767	09/11/2000	Hiroyuki Ishii	P/126-189	4989

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EXAMINER

CORRIELUS, JEAN B

ART UNIT	PAPER NUMBER
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2631

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/659,767

Applicant(s)

ISHII ET AL.

Examiner

Jean B Corrielus

Art Unit

2631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40,41,43,44,58 and 59 is/are allowed.
- 6) ☒ Claim(s) 1-3,17,31 and 45 is/are rejected.
- 7) ☒ Claim(s) 4-16,18-30,32-39,42 and 46-57 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2631

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1-59 are objected to because of the following informalities: claims 1-59, "type" should be replaced by "signal" as "type" covers an infinite number of "modulations". If correction is not made in the next communication, a potential 112 rejection may exist. In addition, the claims need to follow the recitation of each element in logical order for instance, claims 10 and 11, recite "a third amplitude distribution" and "a fifth modulation type", respectively, however, there are no limitations to "a second amplitude distribution"/"third modulation type". The occurrence of any acronym needs to be deleted, and the parenthesis needs to be removed for instance, claim 30, lines 3-4, "DSP(Digital signal processor)" should be rewritten as "digital signal processor". The claims need to be carefully amended to correct for any of such informalities. Appropriate correction is required.

2. Claims 31-39 are objected to because of the following informalities: the claims need to be amended to recite the step plus function in the active tense rather than passive. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to

Art Unit: 2631

which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-3, 17, 31 and 45 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-3, 17 and 45 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims only recite a "discrimination means". Such claims, consequently, are considered as a single means since the "discrimination means" does not seem to appear in combination with another recited element of means. Consequently, such claim is held nonenabling. See MPEP 2164.08(a).

Claim 31 is narrative in form and do not contain positively recited **steps** of a specific process. Note that method claims should set forth **a series of steps** in the active tense in an instruction-like manner thereby reciting an actual method. The claim only recites a **single step** without any additional **steps delimiting** how its use is actually practiced. Dependent claims (if applicable) should further limit base claims by reciting additional method steps in a likewise fashion. Ex parte Erlich 3UPQ2d 1011 at 1017[6].

Art Unit: 2631

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 17 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by

Hachisuka et al US Patent no. 5,598,430.

Hachisuka et al discloses a receiver fig. 6 having a logic discriminator circuit 111 for discriminating whether the modulation type of the reception signal is an analog modulation type or a digital modulation type. See col. 4, lines 28-32.

As per claim 17, the circuit includes means for discriminating whether or not the reception signal is FM signal see 107.

***Allowable Subject Matter***

7. Claims 4-16, 18-30, 32-39, 42, 46-57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Note that the claims need to be amended, if necessary, to overcome any objection sets forth above.

Art Unit: 2631

8. Claims 40, 41, 43, 44, 58 and 59 are allowed. Note that the claims need to be amended, if necessary, to overcome any objection sets forth above.

*Conclusion*

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314

(for informal or draft communications, please label "PROPOSED" or  
"DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

Art Unit: 2631

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean B. Corrielus whose telephone number is (703) 305-4023.

The examiner can normally be reached on Monday-Thursday from 7:00 A.M. to 5:30 P.M.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

  
Jean B. Corrielus

Primary Examiner

TC-2600 8-23-03